

## REMARKS

### Summary of Office Action

Claims 1 and 3-25 were pending in this application.

Claims 1, 3-5, 10, 11 and 20-25 were rejected under 35 U.S.C § 103(a) as being obvious from Japanese Patent 11-149,673 ("Kato") in view of Bahns et al., U.S. Patent No. 5,607,188 ("Bahns").

Claims 6-9 were rejected under 35 U.S.C § 103(a) as being obvious from Kato in view of Bahns and Taira et al. U.S. Patent No. 5,809,003 ("Taira").

### Summary of Applicant's Reply

Applicant respectfully requests reconsideration and allowance of this application in light of the following remarks.

### The § 103(a) Rejection of Claims 1, 3-5, 10, 11 and 20-25

Claims 1, 3-5, 10, 11 and 20-25 were rejected under 35 U.S.C § 103(a) as being obvious from Kato in view of Bahns. In particular, the Examiner correctly notes that Kato lacks "the aspect of the indelible watermark necessarily being visible under normal light" (Office Action, § 2). However, the Examiner also contends that it would have been

obvious to one of ordinary skill to modify Kato "by providing a normal light visible watermark so that the authenticity of the disk would have been readily determined" (Office Action, § 2), as shown in Bahns. Applicant respectfully disagrees.

The system of Kato provides a method for creating a watermark that cannot be forged. In particular, the watermark is not visible under normal light, as the watermark may be identified "only by the reproduction of disks" (Kato, Abstract, ll. 3-4). Bahns teaches a method for providing a visible watermark on an optical disk.

The Manual of Patent Examining Procedure (M.P.E.P.) § 706.02(j) (Contents of a 35 U.S.C. § 103 Rejection) subsection D states that the Examiner should set forth "an explanation of why one of ordinary skill in the art at the time of the invention was made would have been motivated to make the proposed modification." In the present Office Action, the Examiner states that "[c]learly one of ordinary skill in the art would recognize the importance of being able to visually detect the watermark made in the process" of Kato, and that it would have been obvious to one of ordinary skill in the art to modify the process of Kato "by providing a normal light visible watermark so that the authenticity of the disk would have been readily determined"

(Office Action, § 2). Applicant respectfully disagrees, and submits that there is no motivation to combine Kato and Bahns.

Kato teaches away from providing a disc with a visible watermark. In particular, the watermark in Kato is configured to be detected by the specific pattern of the watermark present in the regenerative signal, which is produced when the disc is read. Since only the manufacturers know of the presence of the watermark, a forged copy of a disc with the watermark will be immediately identified (Kato, Technical Problem Section). Therefore, one skilled in the art at the time of the invention would not have been motivated to modify the process of Kato to provide a normal light visible watermark, as the Examiner suggests.

In direct contrast, independent claim 1 of the present invention provides a method for making an information-recording medium having an indelible watermark that is "visible under normal light conditions" in a high-pressure molding process.

Therefore, independent claim 1 is allowable over Kato in view of Bahns. Accordingly, applicant respectfully requests the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Furthermore, claims 3-5, 10, 11 and 20-25 depend from independent claim 1. Therefore, dependent claims 3-5, 10, 11 and 20-25 are allowable over Kato in view of Bahns for at least the reasons that independent claim 1 is allowable over Kato in view of Bahns. Accordingly, applicant respectfully requests the rejection of claims 3-5, 10, 11 and 20-25 under 35 U.S.C. § 103(a) be withdrawn.

The § 103(a) Rejection of Claims 6-9

Claims 6-9 were rejected under 35 U.S.C § 103(a) as being obvious from Kato in view of Bahns and Taira.

Claims 6-9 depend from independent claim 1. Therefore, dependent claims 6-9 are allowable over Kato in view of Bahns and Taira for at least the reasons that independent claim 1 is allowable over Kato in view of Bahns. Accordingly, applicant respectfully requests the rejection of claims 6-9 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

The foregoing demonstrates that claims 1 and 3-25 are patentable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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